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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/904,102	07/13/2001	Phuong Van Luu	02734.0482-05	1512

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EXAMINER

REDDICK, MARIE L

ART UNIT	PAPER NUMBER
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1713

DATE MAILED: 06/20/2002

8

Please find below and/or attached an Office communication concerning this application or proceeding.

42-8

Office Action Summary

Application No.

09/904,102

Applicant(s)

LUU ET AL.

Examiner

Judy M. Reddick

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 October 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 112-117 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 112-117 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4. 6) ☐ Other: _____

DETAILED ACTION

Information Disclosure Statement

1. ***The information disclosure statement filed 09/04/01 has been considered and placed in the application file.***

Drawings

2. ***This application has been filed with informal drawings which are acceptable for examination purposes only. Formal drawings will be required when the application is allowed.***

Claim Rejections - 35 USC § 112

3. ***The following is a quotation of the second paragraph of 35 U.S.C. 112:***

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. ***Claims 112-117 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.***

A) The recited "the polymer to the fibrous web at the drying surface" per claim 112 constitutes indefinite subject matter as per the non-express establishment of proper antecedent basis.

B) The recited "said agent being selected from zirconium compounds wherein the zirconium has a value of +4 per claim 112 constitutes indefinite subject matter as per it not being clear as to what is meant by "value of +4". Does not applicant intend "valence of +4"?

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C) The recited "wherein the creping adhesive composition exhibits a peel force of at least about 300 grams per 12 inches of fibrous web" per claim 112 constitutes indefinite subject matter as per it not being readily ascertainable as to how such further limits the antecedently recited "creping adhesive".

Double Patenting

5. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

6. Claims 112-117 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-5, 26-31, 34 and 35 of copending Application No. 09/496,383. Although the conflicting claims are not identical, they are not patentably distinct from each other because the instantly claimed invention and the claims of copending application '383 overlap in scope.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the

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subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. *The factual inquiries set forth in Graham v. John Deere Co., 383 U.S. 1, 148*

USPQ 459 (1966), that are applied for establishing a background for determining

obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. *Determining the scope and contents of the prior art.*
2. *Ascertaining the differences between the prior art and the claims at issue.*
3. *Resolving the level of ordinary skill in the pertinent art.*
4. *Considering objective evidence present in the application indicating obviousness or nonobviousness.*

9. *Claims 112-117 are rejected under 35 U.S.C. 103(a) as being unpatentable over*

Smigo et al (U.S. 5,281,307) in combination with Hollenberg et al (U.S. 5,246,544).

Smigo et al disclose the use of a cross-linking agent which includes glyoxal, glutaraldehyde and those that are commonly employed for poly(vinyl alcohol) in combination with a poly(vinyl alcohol)/vinyl amine copolymer(PVOH/VAM) as an additive in a paper-making process. See, e.g., the Abstract, col. 4, lines 32-43 and 61-65, col. 5, lines 14-24, col. 6, lines 8-20 and Runs 1-5 of Smigo et al.

The disclosure of Smigo et al differs basically from the claimed invention as per the non-express recognition of a zirconium compound as an operable cross-linker for the PVOH/VAM copolymer. However, the recited "other crosslinking agents commonly employed for poly(vinyl alcohol)" per col. 6, lines 12 and 13 necessarily implies that any cross-linking agent falling within the scope of the genus, including the claimed zirconium compounds, would have been operable within the scope of patentees invention and with a reasonable expectation of success.

Moreover, Hollenberg et al who teach the commonality of using zirconium

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compounds for hydroxylated polymers such as polyvinyl alcohol provide ample motivation to the skilled artisan to employ a zirconium compound as the commonly used x-linker for the polyvinyl alcohol component in the process of Smigo et al and with a reasonable expectation of success, absent some evidence of unusual or unexpected results.

While Smigo et al does not expressly recognize the use of the disclosed additive composition as a creping adhesive, its utility as such is tenable since the modified composition of Smigo et al is essentially the same as and made in essentially the same manner as the claimed adhesive composition. There is nothing viable on this record diffusing this issue.

Claim Objections

10. Claim 112 is objected to because of the following informalities: The rectangular structure housing the structurally depicted formula should be removed. Appropriate correction is required.


Conclusion


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Judy M. Reddick whose telephone number is (703)308-4346. The examiner can normally be reached on Monday-Friday, 6:30 a.m.-3:00 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu can be reached on (703)308-2450. The fax phone numbers for the organization where this application or proceeding is assigned are (703)872-9310 for regular communications and (703)892-9311 for After Final communications.

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Any inquiry of a general nature relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)305-8183.


Judy M. Reddick
Primary Examiner
Art Unit 1713

JMR 
June 19, 2002